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14 BIOGEN IDEC MA INC.

15
16 **IN THE UNITED STATES DISTRICT COURT**
17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**

18
19 BIOGEN IDEC MA INC.,

20 Plaintiff,

21 v.

22 LLOYD TRAN and NEUROBIOGEN, LLC,

23 Defendants.
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Case No.

**COMPLAINT FOR TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION**

1 This is an action for trademark infringement and unfair competition pursuant to the Lanham
2 Act, 15 U.S.C. §§ 1114, 1121, and 1125(a).

3 **PARTIES**

4 1. Plaintiff, Biogen Idec MA Inc. (“Biogen”) is a Massachusetts corporation having an
5 address of 14 Cambridge Center, Cambridge, MA 02142 (“Biogen”).

6 2. Upon information and belief, Defendant, Mr. Lloyd Tran (“Tran”), is an individual
7 having a business address of NASA Research Building 19-1076, P.O. Box 58, Moffett Field, California
8 94035 and/or NASA Research Building 19-1076, P.O. Box 151, Moffett Field, California 94035 and/or
9 5910 Allen Ave., San Jose, California 95123.

10 3. Upon information and belief Defendant, NEUROBIOGEN, LLC is a California limited
11 liability company, which is controlled and directed by Tran sharing the same business address(es) as
12 Tran. NEUROBIOGEN, LLC and Tran are collectively referred to as NEUROBIOGEN unless the
13 context indicates otherwise.

14 **JURISDICTION AND VENUE**

15 4. NEUROBIOGEN is doing business in commerce under the NEUROBIOGEN mark and
16 name and through the website located at <http://www.neurobiogen.com> in California and in commerce in
17 the United States.

18 5. This Court has jurisdiction of the subject matter of this action pursuant to 15 U.S.C.
19 § 1121 and 28 U.S.C. §§ 1331, 1338.

20 6. Venue is proper in this District pursuant to 28 U.S.C. § 1391.

21 **INTRADISTRICT ASSIGNMENT**

22 7. This is an intellectual property action and therefore shall be assigned on a district-wide
23 basis per Civil L.R. 3-2(c).

24 **COUNT I – FEDERAL TRADEMARK INFRINGEMENT - 15 U.S.C. § 1114**

25 8. Biogen, itself and through its predecessors in interest and in title and related companies
26 (hereinafter “Biogen”) is and has been engaged in research and development of pharmaceutical
27 preparations, medical devices and medical diagnostic reagents for more than thirty years, and has built a
28 large and successful business in connection therewith.

1 9. Biogen has used BIOGEN as a mark and name and as the dominant element of marks
2 and names in the U.S. continuously for more than thirty years. Material showing this use is attached
3 hereto as **Exhibit A**. Biogen is commonly referred to by the relevant public and trade and is well known
4 as “Biogen.” See the material attached as **Exhibit B** hereto.

5 10. BIOGEN has been used extensively, continuously, and substantially exclusively as a
6 mark and name and as the first and dominant component of the BIOGEN IDEC marks and names in
7 connection with pharmaceutical research, the development of pharmaceutical products and medical
8 devices and medical diagnostic reagents since long prior to any acts of NEUROBIOGEN complained of
9 herein.

10 11. Biogen is and has long been recognized in the relevant trade and public, as a maker of
11 pharmaceutical products in connection with the care and treatment of Multiple Sclerosis (“MS”), as well
12 as a provider of other support services in connection with MS. By way of example only, Biogen’s
13 AVONEX treatment has the most experience for relapsing forms of MS worldwide, and first appeared
14 (as a mark and name) in commerce no later than May 1996. See **Exhibit C** attached hereto. Biogen’s
15 TYSABRI treatment, approved for relapsing forms of MS in the United States, first appeared (as a mark
16 and name) in commerce, no later than November 2004. See **Exhibit D** attached hereto. Additionally,
17 Biogen’s <http://www.msactivesource.com> website, which helps people with MS live better, was created
18 in or about January 2000. See **Exhibit E** attached hereto.

19 12. Since long prior to any activity of NEUROBIOGEN complained of herein, Biogen’s use
20 of the BIOGEN and BIOGEN IDEC marks and names in connection with pharmaceutical preparations
21 and related products and services has been continuous, commercially significant and substantially
22 exclusive.

23 13. Biogen’s BIOGEN and BIOGEN IDEC marks and names are inherently distinctive as
24 applied to its pharmaceutical preparations and related products and services and business.

25 14. By virtue of Biogen’s use in commerce of its BIOGEN and BIOGEN IDEC marks and
26 names in connection with such pharmaceutical preparations and related products and services and
27 business, such pharmaceutical preparations and related products and services and business have become
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1 well and favorably known to the relevant trade and public under the BIOGEN and BIOGEN IDEC
2 marks and names.

3 15. Biogen is the owner of numerous federal registrations for its BIOGEN and BIOGEN
4 IDEC marks including U.S. Registration Nos. 2,099,409; 3,265,462; 3,165,812; 3,382,316; 3,509,066;
5 and 3,251,473. True and correct copies of Biogen's federal trademark registrations, as found on the U.S.
6 Patent & Trademark Office website are attached hereto as **Exhibit F**.

7 16. NEUROBIOGEN did not register to do business in California before January 09, 2012.
8 See **Exhibit G** attached hereto.

9 17. The domain name neurobiogen.com was not secured by Tran prior to December 24,
10 2011. See **Exhibit H** attached hereto.

11 18. NEUROBIOGEN, LLC, under the direction and control of Tran, is using
12 NEUROBIOGEN as a name and mark and as the dominant component of a name and mark and domain
13 name in connection with its business in California where it is promoting itself as a "bio-pharmaceutical
14 company committed to the discovery and development of new drugs to treat diseases for which there is
15 significant unmet medical need." It indicates that its first drug candidate is a "neuroprotective agent for
16 treatment of ... Multiple Sclerosis." See **Exhibit I** attached hereto.

17 19. Use of NEUROBIOGEN as a mark and name and dominant component of a mark and
18 name and domain name in connection the promotion, development, marketing, and sale of
19 pharmaceutical preparations, particularly those directed to treatment of MS is likely to cause confusion
20 as to source, sponsorship or affiliation with Biogen based on Biogen's prior and extensive use of its
21 BIOGEN and BIOGEN IDEC marks and names in connection with its products and services and
22 business.

23 20. The designation NEUROBIOGEN is confusingly similar to Biogen's BIOGEN and
24 BIOGEN IDEC marks and names in sound, appearance and commercial impression.
25 NEUROBIOGEN's marks and names and domain name feature "BIOGEN" as an integral, phonetic and
26 visual component. Moreover, the word "NEURO" is a generic term and does nothing to mitigate the
27 likelihood of confusion as to source, sponsorship or affiliation based on Biogen's prior and extensive use
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1 of its registered BIOGEN and BIOGEN IDEC marks and its Biogen names in connection with its
2 products and services and business.

3 21. Defendants display the NEUROBIOGEN name on their website in such a way as to
4 emphasize BIOGEN, by displaying the generic term “NEURO” in white, while drawing attention to the
5 word “BIOGEN,” displayed in orange. This deliberate presentation serves to augment the likelihood of
6 confusion, mistake, or deception, between the goods and services of Defendants with those of Plaintiff,
7 or as to whether there is any affiliation or other relationship between them. *See, **Exhibit I***.

8 22. The services and products offered by Defendants under the NEUROBIOGEN marks and
9 names and domain name, or which Defendants represent as intended to be offered under the
10 NEUROBIOGEN marks and names and domain name, are closely related to the products sold and
11 services rendered by Biogen under its registered BIOGEN and BIOGEN IDEC marks and names and
12 particularly, the development and sale of pharmaceutical preparations intended for the treatment of MS.

13 23. Use of NEUROBIOGEN by Defendants is likely to cause confusion or mistake as to the
14 source or sponsorship of its products and services business and as to its affiliation with Biogen.

15 24. Use of NEUROBIOGEN by Defendants is accordingly in violation of Biogen’s rights in
16 its registered BIOGEN and BIOGEN IDEC marks pursuant to 15 U.S.C. § 1114.

17 25. Biogen has no adequate remedy at law. The acts and activities of NEUROBIOGEN
18 complained of herein deprive Biogen of control over its reputation and goodwill, which constitutes
19 irreparable injury.

20 26. The continued acts and activities of NEUROBIOGEN complained of herein constitute
21 willful acts of infringement in derogation of Biogen’s rights in its federally registered trademarks.

22 27. On January 21, 2015, counsel for Biogen wrote to NEUROBIOGEN and demanded that
23 NEUROBIOGEN cease its infringing conduct; NEUROBIOGEN has not responded to this
24 communication and has done nothing to comply. *See **Exhibit J*** attached hereto.

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COUNT II – FEDERAL UNFAIR COMPETITION - 15 U.S.C. § 1125(a)

28. The allegations of the preceding paragraphs of the Complaint are incorporated herein by reference.

29. Biogen has for more than thirty years used BIOGEN and then, and additionally, BIOGEN IDEC as a name and a mark and as the dominant components of names and marks in connection with its business and products and services.

30. The NEUROBIOGEN names and marks and domain name complained of herein are confusingly similar to the BIOGEN and BIOGEN IDEC marks and names in sound, appearance and commercial impression. The use of NEUROBIOGEN, which features “BIOGEN” as an integral phonetic and visual component, merely prefaced with the generic term, “NEURO,” falsely suggests that the Defendants are related to or affiliated with Biogen. That Defendants’ marks, name, and domain name incorporate the whole of the “Biogen” name and BIOGEN mark and only append to them the generic term “NEURO,” which identifies one aspect of Biogen’s business and products only aggravates the likelihood of confusion.

31. The products and services offered or represented as intended to be offered by NEUROBIOGEN are closely related to the business, products and services of Biogen conducted, sold and rendered under the BIOGEN and BIOGEN IDEC marks and names, most notably in connection with the development and sale of pharmaceutical preparations directed to the treatment of MS.

32. Use of NEUROBIOGEN by Defendants as a mark and name and component of marks and names and a domain name in connection with the promotion, development, marketing, and sale of pharmaceutical preparations and any related products and services and business, is likely to cause confusion as to the source or sponsorship of NEUROBIOGEN’s products and services and as to the affiliation of NEUROBIOGEN with Biogen.

33. Use of NEUROBIOGEN by Defendants is likely to mislead persons in the relevant trade and public as to the nature, characteristics, or qualities of the products of Defendants, based on the confusing similarity of Defendants’ names and marks and domain name to the BIOGEN and BIOGEN IDEC names and marks.

34. The acts and activities of NEUROBIOGEN complained of herein constitute false and misleading designations of origin and false and misleading representations in violation of 15 U.S.C. § 1125(a).

35. Biogen has no adequate remedy at law.

36. The acts and activities of NEUROBIOGEN complained of herein deprive Biogen of control over its reputation and goodwill, which constitutes irreparable injury.

37. The acts and activities of NEUROBIOGEN complained of herein were and are undertaken willfully, with knowledge of Biogen 's prior rights, and in bad faith.

PRAYER FOR RELIEF

WHEREFORE, Biogen Idec MA Inc. prays for an Order that Lloyd Tran and NEUROBIOGEN, LLC:

1. Be permanently enjoined from all use of NEUROBIOGEN and any other name or mark which contains or comprises BIOGEN as a mark or name or component of a mark or name or domain name on or in connection with any pharmaceutical preparations or related products or services, or business, including but not limited to the development, marketing, and sale of pharmaceutical preparations for the treatment of MS;

2. Be directed to deliver up to the Court for destruction all print and all other promotional materials which refer to NEUROBIOGEN as a mark or name or component of a mark or name or domain name;

3. Be directed to cancel all domain names, corporate name and fictitious name registrations for any names in the United States which contain or comprise BIOGEN as an element;

4. Be directed to account and pay over to Biogen all profits derived by it in the United States under the NEUROBIOGEN mark and name and domain name;

5. Be directed to pay to Biogen the costs of this action and its reasonable attorneys' fees pursuant to 15 U.S.C. § 1117; and

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1 6. Biogen Idec MA Inc. further prays that it have such other and further relief as this
2 Court may deem warranted.

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4 Dated: February 17, 2015

Respectfully submitted,

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6 HARVEY SISKIND LLP
LAWRENCE J. SISKIND
7 JANE A. LEVICH

8 ECKERT SEAMANS CHERIN & MELLOTT, LLC
9 ROBERTA JACOBS-MEADWAY
JOSHUA L. KIRSCH

10
11 By: _____/s/_____
Jane A. Levich

12
13 Attorneys for Plaintiff
BIOGEN IDEC MA INC.